

RESPONSE UNDER 37 C.F.R. § 1.111
U.S. Application No. 10/825,627

Atty. Docket No. Q80779

REMARKS

Claims 1-19 are all the claims pending in the application.

I. RESPONSE TO REJECTION UNDER 35 U.S.C. § 102/§ 103

Claims 1-19 are rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent Nos. 5,527,649 or 5,718,992 (referred to collectively as “Sato”). The ‘992 patent is a division/continuation of the ‘649 patent, such that each contains essentially the same disclosure. A reference herein to columns and line numbers of “Sato” should be considered a reference to the ‘649 patent.

Applicants respectfully traverse the rejection.

First, as stated in the Amendment filed March 16, 2006, the combination of (i) a film thickness of 0.9 μm or less and (ii) an optical density of 3.3 or more, as recited in the present independent claims, cannot be achieved with the light-shielding layers of Sato, such that the combination of (i) and (ii) is not disclosed (either expressly or inherently) or suggested by Sato. For example, the Declaration Under 37 C.F.R. § 1.132 filed on March 16, 2006, contains results from experiments showing that a light-shielding layer prepared using a light-shielding layer coating solution according to Sato (Y-7 from column 16 of Sato), and having a thickness within the presently claimed range of 0.9 μm or less, does not possess an optical density falling within the presently claimed range of 3.3 or more.

In the Office Action mailed July 7, 2006, the examiner asserts that the claimed subject matter is either inherently disclosed by Sato or would have been obvious from Sato.

Applicants respectfully disagree.

“[A]nticipation by inherent disclosure is appropriate only when the reference discloses prior art that must necessarily include the unstated limitation.” Atofina v. Great Lakes Chem. Corp., 441 F.3d 991, 1000 (Fed. Cir. 2006). Sato does not disclose prior art that must necessarily include the unstated limitation. None of the examples in Sato has a light-shielding layer having the combination of a film thickness of 0.9 μm or less and an optical density of 3.3 or more. The

Declaration filed on March 16, 2006, provides evidence that a light-shielding layer of Sato would not inherently have a combination of a film thickness of 0.9 μm or less and an optical density of 3.3 or more.

In addition, at the time the present application was filed, there was no suggestion that the presently claimed light-shielding layer could be obtained. Further, as described in the present specification, optical density may vary depending on the particle size of the metal particles, the amount of the metal particles, and the thickness of the light-shielding layer. Sato does not provide the necessary disclosure in this regard for a person of ordinary skill in the art to make the presently claimed light-shielding layer.

Still further, in the final Office Action mailed December 27, 2005, the examiner states at Section No. 3 (page 3) that “the end points of the range for the thickness of the layer are 0.3 and 5 microns, therefore the reference *specifically contemplates* a layer having a thickness as small as 0.3 microns which meets the instant claim limitations.” (Emphasis added.)

However, recent Federal Circuit precedent rebuts the examiner’s assertion that Sato “specifically contemplates” a layer having a thickness as small as 0.3 microns. In particular, the Federal Circuit held that the disclosure of a range does not constitute a specific disclosure of the endpoints of that range. *See, Atofina*, 441 F.3d at 1000. According to the Federal Circuit, “[t]he disclosure is only that of a range, ... and the disclosure of a range is no more a disclosure of the end points of the range than it is of each of the intermediate points.” *Id.*

Finally, the presently claimed light-shielding layer achieves unexpectedly superior results with respect to hue and the suppression of the generation of bubbles. As evidence, Applicants are submitting herewith a Declaration Pursuant to 37 C.F.R. § 1.132 of co-inventor Akira Hatakeyama. Mr. Hatakeyama’s Declaration reports experimental results that demonstrate the unexpected superiority of the claimed light-shielding layer. Mr. Hatakeyama’s Declaration together with the other evidence of record, including the experimental results reported in the specification, serve to rebut any alleged *prima facie* case of obviousness.

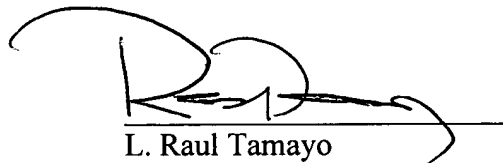
For the foregoing reasons, reconsideration and withdrawal of the present §102/§103 rejection is requested.

II. CONCLUSION

Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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